***United States Court of Appeals***

***for the Second Circuit***

# PETITION FOR REHEARING

74-2455

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

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TIMELY PRODUCTS CORPORATION, RAPHAEL J. COSTANZO, BENJAMIN M. HINES, and LOIS D. HINES,

Plaintiffs,

RAPHAEL J. COSTANZO,

Plaintiff-Appellant,

v.

STANLEY ARRON, VISA-THERM PRODUCTS, INC., MAX ARRON and ANNA ARRON,

Defendants-Appellees.

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CIVIL APPEAL
Docket 74-2455

PETITION FOR REHEARING PURSUANT TO RULE 40(a) OF FEDERAL RULES OF APPELLATE PROCEDURE



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Pursuant to Rule 40(a) of the Federal Rules of Appellate Procedure, the defendant-appellant moves this court for a rehearing for the following reason:

The court, by refusing to decide whether defendant's socks infringed claim two of plaintiff's patent, did not consider or resolve defendant's claim plaintiff abused his patent by bringing suit against two of defendant's customers and sending infringement letters to others. It was by these means plaintiff obtained the lion's share of the market.

The facts found by this court were previously offered by the plaintiff, were not accepted by the lower court, and are not supported by the evidence. Costanzo did claim to have made a sock in February 1964, a claim coming late in the litigation and contradicting previously sworn interrogatories.* (973-996) Costanzo made those sworn statements despite his laboratory notebook (also produced late in the litigation). The validity of the notebook was questionable, a question not decided by the lower court.* (1165-1175) Arron's version was that he got the idea for a low voltage sock from Robert McCarthy of Sonotone battery. Arron claimed putting the battery on the top of the sock was his idea although it turned out to have been anticipated by Winchell. He told Costanzo of this new product and it was Costanzo who developed the aluminum foil element during a time when Arron and Costanzo were partners and were to share equally in all the profits from the socks although they were outside the original

*Numbers in parentheses refer to Transcript.

agreement. (Mem.**p.41, J.A.***p.119) Arron claims Costanzo would not change from the aluminum foil element after it was rejected by a few merchandising firms. They split up and Arron devised the concentrated heat element. Costanzo and Timely, after Arron marketed his sock, discontinued the aluminum foil element and copied the Arron element.

This court has not reached the question of whether Arron's sock infringes the Costanzo patent, although the point is discussed twice:

> "Defendants vigorously contend that neither their accused socks nor even plaintiffs' own socks incorporate a heating element having 'radiation means including a pair of heat conducting sheets of material for sandwiching said resistor strip in heat transfer relationship between them,' as called for in Claim 2. Defendant's socks and all but the earliest model of plaintiffs' socks use nylon strips instead of the aluminum foil strips disclosed in the patent specification. There is much persuasiveness in defendants' argument that their nylon strips cannot, without rendering the words so broad as to be superfluous, be termed a 'heat conducting' material forming a 'radiation means.' However, in view of our ruling that Costanzo's invention was obvious, even assuming its commercial success, it is unnecessary for us to consider whether Claim 2 is readable either on defendants' socks or on plaintiffs' own socks."
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> Opinion, p. 5783

**Mem. refers to District Court's Memorandum.
***J.A. refers to Joint Appendix.

This court again remarks:

> "During the course of prosecution of his patent application, Costanzo narrowed his claims to recite additional elements, such as the 'radiation means in heat transfer relationship to (the) flat resistor strip for defining an expanded radiation surface for said heater.' As we have already remarked, the presence of these added elements in defendants' socks is highly questionable."
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> Opinion, p. 5801

Although defendant treated his relationship with Costanzo as prior art, which, under existing law, he thought he had no duty to disclose, he will pay for his error should the lower court award attorney's fees. Costanzo's and Timely's behavior have not been measured. This court decided it is "highly questionable" defendant's sock infringes plaintiff's patent. It appeared to agree plaintiff's definitions of its patent language so depart from accepted usage as to render the language meaningless.

Arron claims his sock does not infringe plaintiff's patent as a matter of law; that all that is required is a reading of the patent and an examination of his sock. If there is no infringement, then Timely's acts against defendant's customers, if the non-infringement is clear, were fraudulent.[1.]

Defendant seeks a judicial determination of the good faith of Timely and Costanzo. If the claim of infringement is "highly ques-

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1. The District Court found no evidence of bad faith. (Mem. p. 48, J.A., p. 126)

tionable", is it questionable enough to render Timely and Costanzo liable for asserting what they must have known was a false claim? Cases are cited on page 19, et seq., of defendant's brief and will not be repeated.

This court found Arron violated a trade secret belonging to Costanzo. Here, findings diverge from evidence. Arron's use of flexible woven fabric strip may have been taught by the prior art, but none of the patents cited contemplated the use of an element so close to the skin at temperatures well above body heat. Arron believed "concentration of the heat" was the solution, and while the court found his contribution "obvious", it was what made the sock work, and it was not at all what Costanzo had disclosed to him. It is submitted Arron's contribution is as significant as Costanzo's, if not greater. Arron's element was different from the element Costanzo developed during their association. At any rate, the trade secrets claim is so small it may be beneath judicial concern.

When a claim of infringement is so farfetched as to render it frivolous, damages are awarded to the prevailing party. If Arron is to risk penalty for his behavior before the patent office, his claims about plaintiffs' behavior should be decided. If Costanzo and

Timely, as reasonable men, reasonably advised by counsel (the infringement letters were sent by Attorney Fattibene which made them more effective), were guilty of an unreasonable expansion of their patent, they should be liable for claiming an infringement when they knew none existed. If conduct is the measure, justice requires all be measured by the same standard.

RESPECTFULLY SUBMITTED,

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I, Edward F. Kunin, Attorney for the Defendant-Appellee, hereby certify that ~~a~~ Two copies of the foregoing Petition for Rehearing was mailed to Arthur T. Fattibene, Esq., Attorney for the Plaintiff-Appellant, addressed to his office at 2480 Post Road, Fairfield, Connecticut, postage prepaid, this 8th day of September, 1975.

Edward F. Kunin